

REMARKS

Claims 1-6, 8, 9, 11-14, 16-22, 24-28 and 30 are pending. Claims 7, 10, 11, 13, 15, 23, 25, 27 and 29 have been canceled. Claims 1-6, 8, 9, 12, 14, 16, 17, 26 and 30 are amended herein. No new matter has been added as a result of these amendments.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

I. Claims 1-6, 8, 9, 11, 16-25 and 30

The instant Office Action states that Claims 1-6, 8, 9, 11, 16-25 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chern et al. (U.S. Patent No. 6,456,854; hereinafter "Chern") in view of Phelan (U.S. Patent No. 6,240,360), and in further view of MacDoran et al. (U.S. Patent No. 5,757,916; hereinafter "MacDoran"). Applicants respectfully point out that Claims 11, 23 and 25 are canceled herein, and in so much as Claims 11, 23 and 25 are canceled, Applicants respectfully submit that the rejections of Claims 11, 23 and 25 are moot at this time. Moreover, Applicants have reviewed the above-cited references and respectfully submit that the embodiments as recited in Claims 1-6, 8, 9, 16-22, 24 and 30 are patentable over Chern in view of Phelan, and in further view of MacDoran, for at least the following rationale.

A. Missing Claim Features

Independent Claim 1, and similarly independent Claim 17, as amended, recites the features (emphasis added):

A method of location authentication, the method comprising:
receiving a message from a mobile device, the message having significance independent of reporting a geographical location of the mobile device and an automatically generated location stamp attached to an overhead portion of the message, the location stamp indicating the geographical location of the mobile device as an origin of the message;
and

confirming an identity of a sender of the message based on the location stamp; and

determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03.

Similarly, MPEP § 2143 provides:

To establish a prima facie case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants respectfully submit that Chern in view of Phelan, and in further view of MacDoran, fails to teach or suggest each and every element of Claim 1, and similarly Claim 17, as amended. Applicants understand Chern to teach “a system and method for locating and tracking mobile telephone devices via the Internet.” Chern, column 1, lines 57-59 (emphasis added). Applicants further

understand Chern to teach “requesting party enters the required authorization information and a unique identifier of the specific mobile telephone device whose location is desired.” Chern, column 7, lines 10-13 (emphasis added). Applicants understand Phelan to teach:

transmitting a map request to the map server computer from a client computer, and transmitting from the map server computer to the client computer in response to the map request the map data and the coordinate data associated with the area represented by the map

Phelan, column 2, lines 31-35. Applicants understand MacDoran to teach “a method and apparatus for authenticating the identity of a remote electronic device where the identity of such electronic device (or client) is authenticated by use of information specific to the device's geodetic location but that changes constantly” MacDoran, column 1, lines 11-15 (emphasis added).

However, Applicants do not understand Chern in view of Phelan, and in further view of MacDoran, to teach or suggest, for instance, “confirming an identity of a sender of the message based on the location stamp; and determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account”, as claimed.

Chern

As stated above, Applicants understand Chern to teach “a system and method for locating and tracking mobile telephone devices via the Internet.”

Chern, column 1, lines 57-59 (emphasis added). Applicants further understand Chern to teach “requesting party enters the required authorization information and a unique identifier of the specific mobile telephone device whose location is desired.” Chern, column 7, lines 10-13 (emphasis added). Applicants do not understand Chern to teach or suggest, for instance, “confirming an identity of a sender of the message based on the location stamp; and determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account”, as claimed (emphasis added).

For instance, Applicants do not understand “requesting party enters the required authorization information and a unique identifier of the specific mobile telephone device whose location is desired” to be analogous to “confirming an identity of a sender of the message based on the location stamp”, as claimed (emphasis added). Moreover, the instant Office Action states “Chern fails to specifically disclose attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message and confirming an identity of a sender of the message based on the location stamp. See instant Office Action, page 3, section 7 (emphasis added).

Furthermore, the instant Office Action states “[t]he location of the mobile user is relevant to the action requested by the message because the location is utilized by the server in order to determine driving directions.” See instant Office Action, pages 2-3, section 5 (emphasis added). However, the instant Office Action also states “Chern ... does not disclose ‘wherein the action is a delivery,’ ‘a charge to an account,’ or ‘the charge is a credit card charge.’” See instant Office Action, page 6, paragraph 2 (emphasis added).

Phelan

The foregoing notwithstanding, Applicants respectfully submit that Phelan does not overcome the shortcomings of Chern. Applicants understand Phelan to teach:

transmitting a map request to the map server computer from a client computer, and transmitting from the map server computer to the client computer in response to the map request the map data and the coordinate data associated with the area represented by the map

Phelan, column 2, lines 31-35 (emphasis added). Applicants do not understand Phelan to teach or suggest, for instance, “confirming an identity of a sender of the message based on the location stamp; and determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account”, as claimed (emphasis added).

For instance, Applicants do not understand “transmitting ... in response to the map request the map data and the coordinate data associated with the area represented by the map” to be analogous to “confirming an identity of a sender of the message based on the location stamp; and determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account”, as claimed (emphasis added).

MacDoran

Moreover, Applicants respectfully submit that MacDoran does not overcome the shortcomings of Chern and Phelan. Applicants understand MacDoran to teach “a method and apparatus for authenticating the identity of a remote electronic device where the identity of such electronic device (or client) is authenticated by use of information specific to the device's geodetic location but that changes constantly” MacDoran, column 1, lines 11-15 (emphasis added). Applicants further understand MacDoran to teach “the invention does not have the ability to authenticate an individual person.” MacDoran, column 6, lines 63-65 (emphasis added).

Applicants do not understand MacDoran to teach or suggest, for instance, “confirming an identity of a sender of the message based on the location stamp; and determining whether the geographical location identified by the location

stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account", as claimed (emphasis added).

For instance, Applicants do not understand "authenticating the identity of a remote electronic device where the identity of such electronic device (or client) is authenticated by use of information specific to the device's geodetic location" to be analogous to "confirming an identity of a sender of the message based on the location stamp", as claimed (emphasis added). Indeed, Applicants further understand that the method, and similarly the apparatus, taught by MacDoran "does not have the ability to authenticate an individual person." MacDoran, column 6, lines 63-65 (emphasis added). Thus, Applicants respectfully submit that the proffered combination of Chern in view of Phelan, and in further view of MacDoran, does not teach or suggest "confirming an identity of a sender of the message based on the location stamp", as claimed (emphasis added).

Moreover, Applicants do not understand "authenticating the identity of a remote electronic device where the identity of such electronic device (or client) is authenticated by use of information specific to the device's geodetic location" to be analogous to "determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account", as claimed (emphasis added).

B. Nonobvious Combination of References

In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention. MPEP § 2142. In particular,

if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

MPEP § 2143.01 (emphasis added), *citing* In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicants respectfully submit that the combination of Chern in view of Phelan, and in further view of MacDoran, does not satisfy the requirements of a *prima facie* case of obviousness at least because the proffered combination “would change the principle of operation” of Chern. See MPEP § 2143.01. Applicants understand Chern to teach a “[s]ystem and method for locating and tracking mobile telephone devices via the internet”. See Title of Chern.

Moreover, the instant Office Action states:

Chern fails to specifically disclose attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message and confirming an identity of a sender of the message based on the location stamp.

See instant Office Action, page 3, section 7. Applicants respectfully agree with this interpretation of Chern.

Applicants understand Phelan to teach a “[c]omputer system for identifying

local resources". See Title of Phelan. Applicants understand MacDoran to teach a "[m]ethod and apparatus for authenticating the location of remote users of networked computing systems". See Title of MacDoran. Moreover, the instant Office Action states:

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Phelan's method of adding location information to HTTP headers and MacDoran's method of authenticating using location because it offers the advantage of allowing communication with millions of hosts and servers because they use the standard HTTP protocol ... and allowing additional web based services which rely upon location data ... and because it offers the advantage of making spoofing of authentication information difficult because it is constantly changing

See instant Office Action, page 4, paragraph 1 (emphasis added) (citations omitted).

Applicants respectfully submit that modifying Chern so as to require "attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message and confirming an identity of a sender of the message based on the location stamp" (see instant Office Action, page 3, section 7) would significantly change the principal of operation of Chern.

As stated above, Applicants understand Chern to teach a "[s]ystem and method for locating and tracking mobile telephone devices via the internet". See Title of Chern. Therefore, "allowing additional web based services which rely upon location data" and "making spoofing of authentication information difficult"

(see instant Office Action, page 4, paragraph 1) would require Chern to provide additional functionality that is outside the scope of "locating and tracking mobile telephone devices via the internet" (see Title of Chern). Moreover, "allowing communication with millions of hosts and servers because they use standard HTTP protocol" (see instant Office Action, page 4, paragraph 1) imports one or more operational parameters that are not required by Chern to "locat[e] and track[] mobile telephone devices via the internet" (see Title of Chern).

C. Conclusion

For at least the foregoing rationales, Applicants respectfully submit that Claim 1, and similarly Claim 17, as amended, are not unpatentable over Chern in view of Phelan, and in further view of MacDoran, under 35 U.S.C. § 103(a). As such, allowance of Claims 1 and 17 is respectfully requested.

With respect to Claims 2-6, 8, 9 and 16, Applicants respectfully point out that Claims 2-6, 8, 9 and 16 depend from allowable independent Claim 1, and recite further features. With respect to Claims 18-22, 24 and 30, Applicants respectfully point out that Claims 18-22, 24 and 30 depend from allowable independent Claim 17, and recite further features. Therefore, Applicants respectfully submit that Claims 2-6, 8, 9, 16, 18-22, 24 and 30 overcome the rejections under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance as being dependent on an allowable base claim. As such, allowance of Claims 2-6, 8, 9, 16, 18-22, 24 and 30 is respectfully requested.

II. Claims 12-14 and 26-28

Claims 12-14 and 26-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Phelan, and in further view of MacDoran, and in further view of Ray et al. (U.S. Patent No. 6,067,529; hereinafter "Ray").

Applicants respectfully point out that Claims 13 and 27 are canceled herein, and in so much as Claims 13 and 27 have been canceled, Applicants respectfully submit that the rejections of Claims 13 and 27 are moot at this time. Moreover, Applicants have reviewed the above-cited references and respectfully submit that the embodiments as recited in Claims 12, 14, 26 and 28 are patentable over Chern in view of Phelan, and in further view of MacDoran, and in further view of Ray, for at least the following rationale.

A. Missing Claim Features

Claims 12 and 14 are dependent on independent Claim 1 and include the recitations of Claim 1. Claims 26 and 28 are dependent on independent Claim 17 and include the recitations of Claim 17. Hence, by demonstrating that Chern in view of Phelan, and in further view of MacDoran, and in further view of Ray, does not show or suggest the limitations of Claims 1 and 17, it is also demonstrated that Chern in view of Phelan, and in further view of MacDoran, and in further view of Ray, does not show or suggest the embodiments of Claims 12, 14, 26 and 28.

Independent Claim 1, and similarly independent Claim 17, as amended, recites the features (emphasis added):

A method of confirming an authorized transaction, the method comprising:

receiving a message from a mobile device, the message having significance independent of reporting a geographical location of the mobile device and an automatically generated location stamp attached to an overhead portion of the message, the location stamp indicating the geographical location of the mobile device as an origin of the message;

confirming an identity of a sender of the message based on the location stamp; and

determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account.

Applicants respectfully submit that Chern in view of Phelan, and in further view of MacDoran, and in further view of Ray, fails to teach or suggest each and every element of Claim 1, and similarly Claim 17, as amended. Applicants understand Ray to teach:

providing a substantially immediate electronic receipt after a consumer has made a purchase. When a consumer makes a purchase, the sales terminal, which is attached with a short message/e-mail sending capable terminal, can generate and route a short message along with the detailed purchase information to a transport address or alias address associated with the consumer via a Gatekeeper for the Internet for the area that the sales terminal is located in.

See Abstract of Ray (emphasis added).

Applicants respectfully submit that Ray does not overcome the shortcomings of Chern, Phelan and MacDoran. For instance, Applicants do not understand Chern in view of Phelan, and in further view of MacDoran, and in

further view of Ray, to teach or suggest “confirming an identity of a sender of the message based on the location stamp; and determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account”, as claimed (emphasis added).

As stated above, Applicants understand Ray to teach “providing a substantially immediate electronic receipt after a consumer has made a purchase.” See Abstract of Ray (emphasis added). Applicants further understand Ray to teach “generate and route a short message along with the detailed purchase information to a transport address or alias address associated with the consumer via a Gatekeeper for the Internet for the area that the sales terminal is located in.” *Id.* (emphasis added). Applicants do not understand Ray to teach or suggest “confirming an identity of a sender of the message based on the location stamp”, as claimed. For instance, Applicants do not understand “generate and route a short message along with the detailed purchase information to a transport address or alias address associated with the consumer” to be analogous to “confirming an identity of a sender of the message based on the location stamp”, as claimed (emphasis added).

Furthermore, Applicants do not understand Ray to teach or suggest “determining whether the geographical location identified by the location stamp

corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account”, as claimed. For instance, Applicants do not understand “generate and route a short message along with the detailed purchase information to a transport address or alias address associated with the consumer” to be analogous to “determining whether the geographical location identified by the location stamp corresponds to a predetermined location relevant to at least one action identified from the message, the at least one action comprising a charge to an account”, as claimed (emphasis added).

B. Nonobvious Combination of References

In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention. MPEP § 2142. In particular,

if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

MPEP § 2143.01 (emphasis added), *citing* In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The foregoing notwithstanding, Applicants respectfully submit that the combination of Chern in view of Phelan, and in further view of MacDoran, and in further view of Ray, does not satisfy the requirements of a *prima facie* case of obviousness at least because the proffered combination “would change the principle of operation” of Chern. See MPEP § 2143.01.

Applicants understand Chern to teach a “[s]ystem and method for locating and tracking mobile telephone devices via the internet”. See Title of Chern.

Moreover, the instant Office Action states:

Chern fails to specifically disclose attaching to an overhead portion of the message an automatically generated location stamp indicating the geographical location of the mobile device as an origin of the message and confirming an identity of a sender of the message based on the location stamp.

See instant Office Action, page 3, section 7. Furthermore, the instant Office Action states:

Chern ... does not disclose “wherein the action is a delivery,” “a charge to an account,” or “the charge is a credit card charge.”

See instant Office Action, page 3, section 7. Applicants respectfully agree with these interpretations of Chern.

Applicants understand Phelan to teach a “[c]omputer system for identifying local resources”. See Title of Phelan. Applicants understand MacDoran to teach a “[m]ethod and apparatus for authenticating the location of remote users of networked computing systems”. See Title of MacDoran. Applicants understand Ray to teach a “[s]ystem and method for sending a short message containing purchase information to a destination terminal”. See Title of Ray. Moreover, the instant Office Action states:

Ray teaches that when a consumer makes a purchase, the sales terminal can generate a short message along with the detailed purchase information A menu can be displayed on the phone and the consumer can select the desired credit card number and request a receipt. The credit card number can be sent along with the transport address or alias

address to the sales terminal for authorization of the credit card number
....

See instant Office Action, page 6, paragraph 3 (emphasis added) (citations omitted). The instant Office Action further states:

it would have been obvious to one of ordinary skill in the art [sic] at the time the invention was made to combine the method of sending a location identifier with a request from a mobile phone as disclosed in Chern with the method of sending a credit card number across a mobile phone as disclosed in Ray. One of ordinary skill in the art would have been motivated to combine the method of sending a location identifier with a request from a mobile phone as disclosed in Chern with the method of sending a credit card number across a mobile phone as taught in Ray in order to provide substantially immediate purchase information to consumers in a paper-less environment

See instant Office Action, page 7, paragraph 1 (emphasis added) (citations omitted).

Applicants respectfully submit that modifying Chern so as to require “sending a credit card number across a mobile phone” (see instant Office Action, page 7, paragraph 1) would significantly change the principal of operation of Chern. As stated above, Applicants understand Chern to teach a “[s]ystem and method for locating and tracking mobile telephone devices via the internet”. See Title of Chern. Therefore, “sending a credit card number across a mobile phone” (see instant Office Action, page 7, paragraph 1) would require Chern to provide additional functionality that is outside the scope of “locating and tracking mobile telephone devices via the internet” (see Title of Chern).

Indeed, such functionality would necessarily import one or more

operational parameters that are not utilized by Chern to “locat[e] and track[] mobile telephone devices via the internet” (see Title of Chern). For instance, “locating and tracking mobile telephone devices via the internet” (see Title of Chern) does not require

“a consumer makes a purchase, the sales terminal can generate a short message along with the detailed purchase information A menu can be displayed on the phone and the consumer can select the desired credit card number and request a receipt. The credit card number can be sent along with the transport address or alias address to the sales terminal for authorization of the credit card number

See instant Office Action, page 6, paragraph 3 (emphasis added) (citations omitted). Therefore, modifying Chern to further include “sending a short message containing purchase information to a destination terminal” (see Title of Ray) would require many different steps that are not used to “locat[e] and track[] mobile telephone devices via the internet” (see Title of Chern).

C. Conclusion

Applicants respectfully submit that Claim 1, and similarly Claim 17, as amended, are allowable over Chern in view of Phelan, and in further view of MacDoran, and in further view of Ray, for at least the aforementioned rationales. As such, allowance of Claims 1 and 17 is respectfully requested.

With respect to Claims 12 and 14, Applicants respectfully point out that Claims 12 and 14 depend from allowable amended independent Claim 1, and recite further features. With respect to Claims 26 and 28, Applicants respectfully point out that Claims 26 and 28 depend from allowable amended independent

Claim 17, and recite further features. Therefore, Applicants respectfully submit that Claims 12, 14, 26 and 28 overcome the rejections under 35 U.S.C. § 103(a), and that each of these claims are thus in a condition for allowance as being dependent on an allowable base claim. As such, allowance of Claims 12, 14, 26 and 28 is respectfully requested.

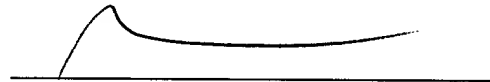
CONCLUSION

In light of the above-listed remarks, reconsideration of the rejected claims is requested. Based on the amendments and arguments presented above, it is respectfully submitted that Claims 1-6, 8, 9, 12, 14, 16-22, 24, 26, 28 and 30 overcome the rejections of record. Therefore, allowance of Claims 1-6, 8, 9, 12, 14, 16-22, 24, 26, 28 and 30 is respectfully solicited.

Should the Examiner have a question regarding the instant amendment and response, the Applicants invite the Examiner to contact the Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,
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